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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,737	07/09/2001	Edouard G. Lebel	S-21043B	1621

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/901,737

Applicant(s)

LEBEL ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 9, 14, 15, 20-23 and 30.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 3. NOTE: New issues: Claim 30 lacks antecedent basis for the limitation "the microbial source".

Continuation of 5. Applicant's reply WOULD HAVE overcome the following rejection(s): Objection to claims 8-9, 16-17 and 23; previous 112, 2nd rejection. 103 over Van Ooyen in view of Lao.

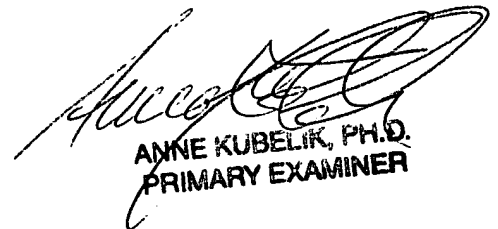
Continuation of 11. does NOT place the application in condition for allowance because:

112, 1st, written description: Applicant urges that the specification teaches 3 *T fusca* endoglucanases and the cited references describe other cellulases from bacterial and fungal sources, citing Collmer, Ghanges, Wilson, Jung, Lao, and Thomas. This is not found persuasive because Collmer, Ghanges, Jung and Lao only teach the *T fusca* endoglucanase genes and Thomas only teaches enzymes, not sequences. Applicant urges that Wilson teaches numerous genes on pg 46 and 56. This is not found persuasive because what is taught on pg 46 is enzymes and *T fusca* genes. While genes from three bacteria other than *T fusca* are reference on pg 56, it is not clear which of these encode B-1,4, endoglucanases - certainly several are identified as "exocellulases" which would not be endoglucanases - and which of any B-1,4, endoglucanases are thermostable. Applicant urges that a search of Genbank found three endoglucanase genes. These will not be considered because Applicant did not provide a good and sufficient reason why the evidence is necessary and not earlier presented.

112, 1st, enablement: Applicant urges that every possible embodiment covered by the claims be given a detailed description; here the critical element is not the endoglucanase but the use of appropriate regulatory sequences. This is not found persuasive because the critical element is expression of endoglucanases in plant; both the nucleic acids encoding the B-1,4-endoglucanases and the promoters must be described for the invention to be described. Plant promoters are described in the literature within the full scope of the claims; nucleic acids encoding B-1,4-endoglucanases from bacteria and fungi and not described within the full scope of the claims. Applicant urges that other can take Applicant's example and substitute other endoglucanases. This is not found persuasive. The ability of the public successfully to design around -- to use the patent disclosure to design a product or process that does not infringe, but like the claimed invention, is an improvement over the prior art -- is one of the important public benefits that justify awarding the patent owner exclusive rights to his invention (ATD Corp. v. Lydall Inc. (DC EMich) 43 USPQ2d 1170, 1178). On the one hand, claims must be "particular" and "distinct," as required by 35 U.S.C. § 112, so that the public has fair notice of what the patentee and the Patent and Trademark Office have agreed constitute the metes and bounds of the claimed invention. Notice permits other parties to avoid actions, which infringe the patent, and to design around the patent (London v. Carson Pirie Scott & Co. (CA FC) 20 USPQ2d 1456, 1458).

Continuation of 13. Other:

Applicant is reminded that the RCE filed 21 July 2005 was not accepted because the Office action of 5/19/05 was not final. See MPEP 706.07(h) .



ANNE KUBELIK, PH.D.
PRIMARY EXAMINER